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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,888	01/07/2004	Paul Elkins JR.	ELK-001CIA	8166

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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/753,888	Applicant(s) ELKINS, PAUL	
	Examiner Gerald B. Klebe	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-15, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
9 July 2005

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/03/04;08/30/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (US 4116455), cited by Applicant, in view of Anderson (US 5285742).

a. Dotson et al. ("Dotson") discloses a snowskateboard comprising: **(re: claims 1 and 10)**
a support deck (Fig 1, item 16) having an upper side and a lower side opposite said upper side; a first truck (12) mounted to said lower side, said first truck including a first yoke having a first axle (28) disposed in said first yoke; a first left runner (14) disposed over said first axle and a first right runner disposed over said first axle opposite said first left runner; a second truck mounted to said lower side distal from said first truck, said second truck including a second yoke having a second axle disposed in said second yoke; a second left runner disposed over said second axle and a second right runner disposed over said second axle opposite said second left runner.

Regarding the further recitations of claim 10 relative to the trucks, the examiner notes that Dotson et al. further discloses first and second trucks each having base body including a mount side and a support side opposite the mount side the base body including a front end and a rear end and a first pivot support formed in the support side proximate the rear end and a first coupling support formed in the support side proximate the front end of the first truck base body

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and the truck comprising a yoke having a yoke body including an axle support portion and a coupling portion configured to couple to the coupling support and the pivot portion configured to couple to the pivot support. (The examiner notes that, clearly, the recitations of the claim regarding the details of the trucks, including the recited dispositions of the support portion and the pivot portion of the yoke are broadly the recitations of the structure of conventional trucks as used on skateboards as shown in the figures of Dotson and therefore are considered well-known in the art; refer col 2, lines 55-56.)

b. Dotson lacks explicit disclosure of first and second biasing mounts for each of the runners, the biasing mounts being disposed over the first and second axles of the trucks, respectively, and configured to bias the biasing mounts in a torsional direction relative to the respective axle.

c. However, Anderson teaches mounts for the snow gliding vehicle runners wherein (**re: claim 1 and claim 10**) the mounts for the runners are disposed over the axle carrying the respective runner (refer Fig 5) and have a biasing member (80) configured to bias the mount in a torsional direction relative too the respective axle.

d. Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the snowskateboard of Dotson to include biasing members configured to bias the runner mounts in a torsional direction relative to the respective axle in accordance with the teachings of Anderson in order to stabilize the runners from the flexion and vibration normally encountered in use of the vehicle and thereby improve the life-span of the runner and vehicle as suggested by the reference at column 6, lines 20-27.

Regarding the features of claims 2 and 11, wherein the biasing mounts are configured to bias each respective runner in at least one of a level position, a rear-rotated position and a forward-rotated position, as taught by Anderson the biasing mounts are configured to bias the runners in a level position.

Examiner's note: As taught by Anderson the runners are biased to the level position; however, the biasing mounts of Anderson may be configured as a matter of mere design choice to biasedly orient the runners to any one of the positions of level, rear-rotated, and forward-rotated by selecting and installing into the runner mounting biasing members having appropriate "relaxed-state" lengths.

Regarding the limitations of claims 3 and 12, the runners disclosed by Dotson each have at least one protuberance (items 35) extending from the snow-side surface of the runner.

Regarding claims 4 and 13, the protuberances of Dotson each include a rail extending from the protuberance at a location on the protuberance distal from the snow-side surface of the runner (taken as the gliding surface, not separately numbered, of the protuberances, items 35).

Regarding the limitations recited in claims 5 and 14 wherein the rails are selected from the group consisting of metal, ceramic, diamond hardened plastic, and hardened polymer, as applied to claims 4 and 13 from which claims 5 and 14 depend, respectively, the combination of Dotson and Anderson is silent as to the material of the rails are made. However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have selected material for the rail from any of the recited materials, since it has been held to be within the general skill of a worker in the art to select a know material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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Regarding the limitations of claims 6 and 15 wherein the biasing members comprise a torsion spring disposed over the respective axles, Anderson shows the biasing members disposed over the respective axles to be pneumatic or gas shock absorbers, but is silent as to the shock absorbers comprising springs. However, the examiner takes Official Notice that it is old and known that shock absorbers as taught by Anderson include internal springs that restore the shock absorber to its normal relaxed length upon release of the pneumatic pressure.

Claim Rejections - 35 USC Sections 102 or 103(a)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as being obvious over the combination of Dotson et al. (US 4116455), cited by Applicant, and Anderson (US 5285742).

a. As discussed above, relative to claims 1 and 2 the combination of Dotson et al. ("Dotson") and Anderson discloses a snowskateboard comprising (**re: claim 1**) a set of

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snowskateboard runners each runner being mounted over a skateboard truck axle, the runners further comprising a first biasing mount mounted in the first left runner and a first biasing mount mounted in the first right runner and a second biasing mount mounted in the second left runner and a second biasing mount mounted in the second right runner and wherein the first biasing mount is disposed over the a first skateboard truck axle and the second biasing mount is disposed over the second skateboard truck axle, and further (**re: claim 2**) wherein each of the first biasing mount and the second biasing mount are configurable to bias each respective said first left runner, said first right runner, said second left runner and said second right runner into at least one of a level position, a rear rotated position and a forward rotated position **in which the method, comprising the steps of (re: claim 19)** selecting a set of right and left first snowskateboard runners and a set of right and left second snowskateboard runners and each of said runners being mounted on a respective skateboard truck axle having, respectively, a first biasing mount mounted on each of the left and right first runners and a second biasing mount mounted on each of the left and right second runners, wherein each respective biasing mount is disposed over its respective truck axle and the step of adjusting each of the respective biasing mounts to configure each in a at least one of a level position, a rear rotated position and a forward rotated position, wherein (**re: claim 20**) the said first and said second biasing mounts are configured to bias the mount in a torsional direction relative to their respective axles, **the claimed method is considered inherent.**

b. Therefore, it is the examiner's position that the combination of Dotson et al. and Anderson as applied above to claims 1 and 2 teaches the claimed method of claims 19-20 because the method is inherently disclosed. The rationale for this inherency is that the prior art

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device of the combination of Dotson et al. and Anderson, in its normal and usual operation of use, would necessarily perform the claimed steps of the method. See MPEP Sec. 2112.02 and refer In re King, 801 f2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

c. However, even if not anticipated, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the combination of Dotson et al. and Anderson to include the claimed method of claims 19-20.

Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structures of the combination of Dotson et al. and Anderson.

Allowable Subject Matter

6. Claims 7-9, and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art made of Record

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Ouellette; of Breuer et al.; of Melcher; of Link; of Farally-Plourde; and of Baldwin each show features in common with some of the other structures of the inventive concept disclosed in the instant application.

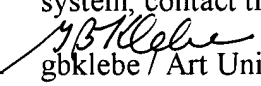
Conclusion

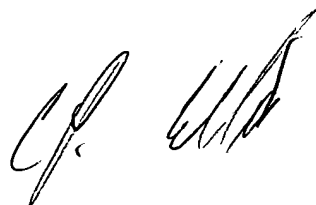
8. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 571-272-6695; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 571-272-6914.

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Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 9 July 2005



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